

Remarks

Claims 1, 4-10, 19, 28, 29, 31, 35, 45, 58, 68, 78, 88 and 95-175 were previously pending in this application.

By this Amendment, claims 1, 4-10, 19, 58, 68, 78, 88, 96-116 and 140-175 are cancelled without prejudice or disclaimer. Applicant reserves the right to pursue the subject matter of the cancelled claims in continuing applications.

Claim 95 has been amended. Support for this amendment can be found within the body of the claim itself.

New claims 176-178 have been added. Support for these claims can be found on page 6, first full paragraph.

As a result claims 28, 29, 31, 35, 45, 95, 117-139 and 176-178 are pending for examination with claims 28, 35, 45 and 95 being independent claims.

No new matter has been added.

This Amendment does not necessitate any additional claims fees.

Rejection under 35 U.S.C. §102

Claims 28, 29, 31, 35, 45, 95 and 117-139 are rejected under 35 U.S.C. §102(b) as being anticipated by Laposata (1998, Prog. Lipid Res. 37(5):307-316). The Examiner states that “Laposata teaches that FAEE’s correlate to the incidence of ethanol intake in liver and adipose tissue found in human subjects”. The Examiner states that “while the applied reference does not expressly disclose the amount of FAEE that is present in order to make the determination of ethanol intake, because such a determination is made therein ... the amount would be within the range instantly claimed and is therefore inherent”. Applicant respectfully traverses.

For a reference to anticipate a claimed invention it must teach each and every limitation of the claims either explicitly or inherently. For inherency, the missing descriptive matter must be necessarily present in that which is described by the reference. In re Robertson, 160 F.3d 743, 745, 49USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The claimed invention relates to separate determinations of FAEE content in the liver and adipose tissue followed by calculation of total combined liver and adipose FAEE content (i.e., sum total of liver and adipose FAEE content), or the ratio of liver FAEE content to adipose FAEE content. The claimed invention also relates to measurement of ethyl arachidonate (a species of FAEE) in liver or adipose. All of these readouts are intended as indicators of ethanol intake in a subject.

Applicant disagrees with the Examiner's interpretation of the Laposata reference. The Laposata reference does not teach the afore-mentioned markers, either explicitly or inherently. It does not teach total combined liver and adipose FAEE content as a marker of ethanol intake. It does not teach ratio of liver FAEE content to adipose FAEE content as a marker of ethanol intake. It does not teach liver or adipose ethyl arachidonate content as a marker of ethanol intake. Accordingly, the reference cannot anticipate the claimed invention either explicitly or inherently.

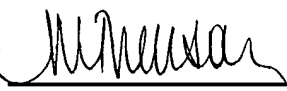
Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

Conclusion

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's representative at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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